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10/786,470

02/25/2004

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23474 7590 06/24/2008  
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EXAMINER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/786,470  
Filing Date: February 25, 2004  
Appellant(s): HOFMANN ET AL.

\_\_\_\_\_  
Terryence F. Chapman  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 28, 2008 appealing from the Office action mailed November 1, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP

JP 2002038246 discloses the features including the claimed Cu based alloy composition ([0011]). Therefore, when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly have been motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). As stated in In re Peterson, 315 F.3d 1325, 1329-30, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003), that "A prima facie case of obviousness typically exists when the ranges of a claimed composition overlap the ranges disclosed in the prior art". Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

#### **(10) Response to Argument**

Applicant's arguments filed March 28, 2008 have been fully considered but they are not persuasive.

The appealed independent claim 19 and prior art alloys compositions are summarized in Table below:

Art Unit: 1700

	Appealed claim 19	JP 246 [0011]		
Cu	60-70	bal		
Sn	1.5-2.5	0-10		
Fe/Co	0.01-0.5	Fe 0-3 Co 0-1		
Ni	0.01-0.5	0-10		
Mn/Si	0.01-0.5	Mn 0-1 Si 0-1		
Mg	$\leq 3$	0-1		
P	$\leq 0.2$	0-0.5		
Ag, Al, As, Sb, Ti, and/or Zr	Each $\leq 0.5$	Ag 0-1 Al 0-5	As Sb	Ti 0-1 Zr 0-0.5
Zn	Bal.	0-40		
		Cr, B, REM optional		

Appellants argue that “[T]he disclosed range of JP ‘246 is so broad as to encompass a very large number of possible distinct compositions as the only metal specifically required is copper and the specific alloys disclosed in JP 246 are outside of the scope of the present claims and do not even present a showing of prima facie obviousness.”

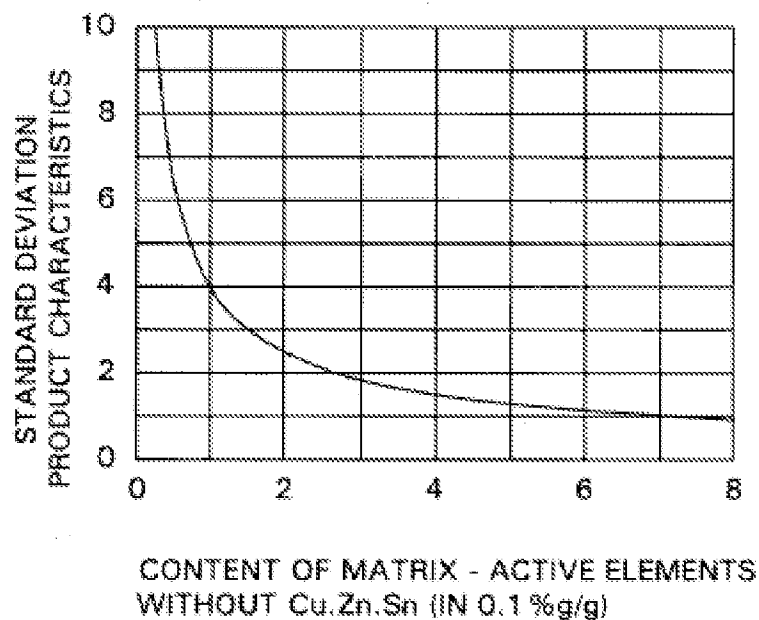
However, appellants fail to show that the claimed composition is critical and possesses unexpected result.

Art Unit: 1700

Appellants argue that the examples of the cited reference do not disclose the claimed alloy composition. But, it is well settled that the examples of the cited reference are given by way of illustration and not by way of limitation. In re Widmer, 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965), In re Boe, 148 USPQ 507 (CCPA 1966), and In re Snow, 176 USPQ 328.

Appellants argue that "As shown in Figure 1, with respect to the content of the matrix-active elements, the dispersion of the technological characteristics decrease asymptotically over a certain range which leads to the conclusion that as high as possible of the matrix-active elements should be supplied."

But, Figure 1 of the instant specification below:



fails to show the effect of any matrix-active elements with respect to apparent yielding point, tensile strength, ductile yield, hardness, grain size, and/or hardening

Art Unit: 1700

ability. Figure 1 merely shows that matrix-active elements are needed to be greater than zero in order to reduce the “standard deviation product characteristics”.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sikyin Ip/

Sikyin Ip

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Art Unit: 1700

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